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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,033	08/22/2001	Ieyasu Kobayashi		8235

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Rader Fishman & Grauer
1233 20th Street N W Suite 501
Washington, DC 20036

EXAMINER

RIVERA, WILLIAM ARAUZ

ART UNIT	PAPER NUMBER
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3654

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/914,033	Applicant(s) KOBAYASHI ET AL.	
	Examiner William A. Rivera	Art Unit 3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,9,13-15 and 23 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6,9,13-15 and 23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Approval for Reopening of Prosecution

In accordance with 37 CFR 1.198, this application is being reopened with Director approval below.

Claim Rejections - 35 USC § 112

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to Claim 6, the phrase "the difference Rc" has no antecedent basis in the claim. It appears that the term "Rc" should be replaced with the term --R--.

Claim Rejections - 35 USC § 102 & 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 6 and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sasaki et al (U.S. Patent No. 4,576,344).

With respect to Claim 6, both the polyester film roll of Sasaki and that of the applicant's is wrinkle free. Sasaki teaches working examples of a polyester films having lengths of 6,000 m or 5,000 m, widths of 650 mm, and thicknesses of 8 μ m or 10 μ m. Sasaki teaches that the polyester film rolls of the two working examples, which had roll

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hardnesses of 98 and 96, respectively, did not wrinkle. As such, the polyester film rolls of the two working examples of Sasaki have the same film length, width, thickness, and rolling hardness as the applicants polyester film roll. A person of ordinary skill in the art would have readily recognized that a manufactured cylindrical object will have some deformities and hence will have a maximum and a minimum diameter. Moreover, the same person of ordinary skill in the art would have appreciated the desirability of limiting the difference between the maximum diameter and the minimum diameter of the cylindrical object in order to provide uniformity to the cylindrical object. Therefore, because the polyester film roll of Sasaki has the same film length, width, thickness, and rolling hardness as the applicants' polyester film roll, and achieves the same result of a wrinkle free film, there exists a *prima facie* basis for finding that Sasaki's working examples necessarily have maximum and minimum diameters sufficiently close to meet the relationships of the claim.

In the alternative, however, even assuming *arguendo* that the polyester film rolls of Sasaki might not necessarily have maximum and minimum diameters sufficiently close to meet the relationships of the claims, it would have been obvious for a person of ordinary skill in the art to improve the polyester film roll of Sasaki by controlling the maximum diameter and the minimum diameter of the film rolls to meet the relationships of the claims. One of ordinary skill in the art would have had a design incentive to optimize the uniformity of the cylindrical film rolls of Sasaki. Applicants have not alleged that the proposed improvement would have been beyond the level of ordinary skill in the

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art or that the improvement would have produced results which one of ordinary skill in the art could not have predicted.

With respect to Claim 9, it is deemed that the flexural modulus of the core of Sasaki et al in the circumferential direction is not less than 13 GPa since the polyester film rolls of the two working examples of Sasaki have the same film length, width, thickness, and rolling hardness as the applicant's polyester film roll. In the alternative, however, even assuming *arguendo* that that is not the case, it would have been obvious to one of ordinary skill in the art to have provided the core with a high flexural modulus (i.e. not less than 13GPa) in the circumferential direction to obtain a stiff core to contribute in obtaining a more cylindrical roll, as noted above. It would have been obvious to one of ordinary skill in the art that the claimed flexural modulus range would have been an obvious matter of design choice dependent upon a desired core stiffness and manufacturing costs.

Claims 13-15 and 23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sasaki et al (U.S. Patent No. 4,576,344) as applied to Claims 6 and 9 above, and further in view of Ogawa et al (U.S. Patent No. 4,911,951).

With respect to Claims 13-15 and the difference R between the maximum and minimum diameter values, the above rejection of claims 6 and 9 is incorporated by reference. Sasaki et al teach a polyester film roll 4 free from wrinkles and rolled on a

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core 2 wherein the polyester film is a film used for the support of a magnetic recording medium (see column 8, lines 55-57).

With respect to Claim 23, the above rejection of claims 6 and 9 is incorporated by reference. Sasaki et al teach all the elements of the roll except for first maximum and second maximum perpendicular line lengths of the lines and the magnetic layer being a magnetic type. However, it is deemed inherent that, in the roll of Sasaki et al, there is a curved line representing a plurality of diameter measurements and respective first and second maximum perpendicular lines; therefore, the same analysis above as applied to claims 6 and 9 regarding maximum and minimum diameter values applies in the same way.

With respect to claims 13-15 and 23, Sasaki et al does not teach the roll having a ferromagnetic/coating layer being rolled in the inner side. However, Ogawa et al (see at least Figures 1 and 2, and Column I, lines 50-62 and Column 4, lines 23-31) teach the use of a ferromagnetic/coating layer and the ferromagnetic/coating layer being disposed on a polyester film on the inside. It would have been obvious to one of ordinary skill in the art to provide a ferromagnetic/coating layer to the polyester film of Sasaki, as taught by Ogawa et al, for the purpose of manufacturing a roll magnetic recording media. It would have further been obvious to one of ordinary skill in the art to wind the roll with the ferromagnetic/coating layer on the inside, as taught by Ogawa et al, for the purpose of protecting the layer from foreign substances. Also, the use of magnetic recording medium for digital recording is notoriously old and well known. As such, it would have

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been obvious to one of ordinary skill in the art that the magnetic recording medium roll could be used for a digital recording.

Response to Arguments

Applicant's arguments with respect to claims 6, 9, 13-15 and 23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William A. Rivera whose telephone number is 571-272-6953. The examiner can normally be reached on Monday to Friday - 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Q. Nguyen can be reached on 571-272-6952. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William A Rivera/
Primary Examiner, Art Unit 3654

March 13, 2010

/David L. Talbott/

Director, Technology Center 3600